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<p>This Opinion is Not Citable as Precedent of the TTAB</p>

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Palmer Asphalt Company

Serial No. 76335059

S.C. Yuter, J.S.D. for Palmer Asphalt Company.

Khanh M. Le, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Holtzman, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Palmer Asphalt Company [applicant] has applied to register the mark DUREX for goods ultimately identified as "asphalt and elastomeric coatings and cements, other than protective coatings applicable to various substrates for use as a lining or coating, all for roofing, waterproofing and dampproofing,"¹ in Class 19. The application is based

¹ The identification's exclusionary language, i.e., "other than protective coatings applicable to various substrates for use as a lining or coating," was added by an amendment filed during this appeal and accepted by the examining attorney.

on applicant's claim of use of the mark in commerce for the identified goods, such use commencing in 1932 by a predecessor in interest to applicant.

The examining attorney has refused registration, in view of the prior registration of DUR-X-LINE for goods identified as "protective coatings applicable to various substrates for use as a lining or coating," in Class 2.² The examining attorney contends that there is a likelihood of confusion among prospective consumers for the respective goods of applicant and registrant. The registrant is Durex Products, Inc.

Applicant and the examining attorney have filed briefs, and applicant filed a reply brief after the examining attorney accepted applicant's amendment of the identification during appeal, but nonetheless maintained the final refusal of registration. Applicant did not request an oral argument.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and In re E.I.

² Registration no. 1197589 issued June 15, 1982; Section 8 & 15 affidavits filed; renewed.

du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, two key considerations are the similarities of the marks and the relatedness of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin by considering the goods, because applicant strongly contends that, by amending its identification to exclude from its coverage the precise identification in the cited registration, applicant has effectively established that there can be no likelihood of confusion. Registrant's identification is "protective coatings applicable to various substrates for use as a lining or coating," while applicant's amended identification is (emphasis added) "asphalt and elastomeric coatings and cements, *other than protective coatings applicable to various substrates for use as a lining or coating*, all for roofing, waterproofing and dampproofing."

When comparing the goods in an application and registration, we must focus on the identifications themselves, rather than any extraneous evidence about what the applicant or registrant may actually be doing. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("Indeed, the second DuPont factor

expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration") (internal quotation marks omitted).

Prior to applicant's insertion of the language intended to make it clear that applicant's identification excludes registrant's products, we would have agreed with the examining attorney's contention that registrant's identification is broadly written and would have to be read to include products such as those identified by applicant's earlier identification, i.e., "asphalt and elastomeric coatings and cements, all for roofing, waterproofing and dampproofing." Specifically, applicant's earlier identification covered certain "coatings" and "cements" for "roofing, waterproofing and dampproofing." Absent any restriction to the contrary, such coatings and cements would have to be read to include goods for both external application and substrate³ application. In other words, as originally identified, applicant's goods would be encompassed by the broad specification of registrant's

³ We take judicial notice of the following dictionary definition of substrate -- "a substratum" -- and of substratum -- " 1. that which is spread or laid under something else; a stratum or layer lying under another. 2. something that underlies or serves as a basis or foundation." The Random House College Dictionary 1311 (Rev. 1st ed. 1982).

goods. That would mean the identifications were overlapping and the goods theoretically competitive.⁴

By its amendment, applicant has effectively excluded from the scope of its identification those coatings and cements that could be used on substrates and has effectively restricted its goods to those that can be used for external applications, in roofing and in other applications where externally-applied waterproofing or dampproofing is required. While this amendment to the identification means that the goods theoretically do not overlap, it does not mean they are unrelated. Clearly, there may be instances when, for example, a roofer would have need of a protective coating for a substrate layer of roofing material and would finish the roofing job with an externally applied coating or cement. Under such circumstances, applicant's and registrant's goods would be complementary and would, therefore, still have to be presumed to be marketed to the same classes of consumers through the same channels of trade. Martin's Famous Pastry

⁴ When identifications do not include restrictions as to channels of trade, classes of consumers, or particular uses, we must presume they are suitable for all possible normal uses for such goods and are sold to all possible consumers through any customary channels of trade for such goods. Kangol Ltd. v. KangaROOS U.S.A., Inc. 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

We find that the goods remain related, for likelihood of confusion purposes, notwithstanding applicant's amendment during the appeal. We are not persuaded otherwise by applicant's argument that its business is restricted to the roofing field, and that registrant's business is restricted to the mining field. First, even applicant's amended identification does not restrict its goods to use in the roofing field, as it encompasses coatings and cements that can be used in any sort of waterproofing or dampproofing application, so long as the application is external. Second, while registrant's web site, introduced by applicant, may reveal that registrant is in the mining business, and even that it uses its registered mark for particular mining machine parts and accessories not listed in its registration, this does not establish that registrant is not also in the business of selling protective coatings that can be used in any number of ways, as stated by the identification in its registration. As the examining attorney has informed the applicant, an applicant cannot utilize extrinsic evidence to restrict the scope of a registrant's identification. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986).

Having determined that the goods are related for likelihood of confusion purposes, we now turn to a comparison of the marks. Applicant's mark is DUREX and registrant's mark is DUR-X-LINE. The examining attorney has argued that the LINE portion of registrant's mark is weak because it suggests that registrant has a "line" of products. Therefore, the examining attorney concludes, the DUR-X portion of the mark is dominant and is pronounced the same as applicant's mark and would have the same connotation.

We agree with the examining attorney that the LINE portion of registrant's mark may connote a "line" of protective coatings; but it may also connote that registrant's products are used for lining or coating substrates. Either connotation is highly suggestive or descriptive for registrant's goods. Therefore, we also agree with the examining attorney's conclusion that the DUR-X portion of registrant's mark is dominant. Notwithstanding the connection of LINE to DUR-X by a hyphen, the DUR-X portion of registrant's mark is dominant in the articulation of the mark, because it comes first, and in regard to the mark's overall connotation. In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that,

for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety").

We find the marks DUREX and DUR-X-LINE very similar in sound and connotation (i.e., they both have a connotation of durability). Given the use of these similar marks on related goods that must be presumed to travel through the same channels of trade to the same classes of consumers, we find that confusion is likely, or that consumers will be mistaken about the source of the respective products.

Decision: The refusal of registration under Section 2(d) is affirmed.